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JUN 07 2007

OFFICE OF PETITIONS

In re Application of	:	
Juen-Kuen Lin et al.	:	
Application No. 09/741,072	:	DECISION ON PETITION UNDER
Filed: December 21, 2000	:	37 C.F.R. §1.181(A)
Attorney Docket Number:	:	
200690US2CONT	:	
Title: WAFER POLISHING HEAD	:	

This is a decision on the petition under 37 CFR §1.181(a), filed January 23, 2006, to withdraw the holding of abandonment.

The Office regrets the period of delay in issuing this decision.

Background

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR §1.113 in a timely manner to the final Office action mailed April 18, 2002, which set a shortened statutory period for reply of three months. No response was received, and no extensions of time under the provisions of 37 CFR §1.136(a) were obtained. Accordingly, the above-identified application became abandoned on July 19, 2002. A notice of abandonment was mailed on December 3, 2002.

With the present petition, Petitioner has asserted that neither of these mailings was received, however Petitioner has not established that the holding of abandonment should be withdrawn. A discussion follows.

The Relevant Regulations and Portion of the MPEP

37 C.F.R. § 1.33 sets forth, in toto:

(a) Correspondence address and daytime telephone number. When filing an application, a correspondence address must be set forth in either an application data sheet (§ 1.76), or elsewhere, in a clearly identifiable manner, in any paper submitted with an application filing. If no correspondence address is specified, the Office may treat the mailing address of the first named inventor (if provided, see §§ 1.76(b)(1) and 1.63(c)(2)) as the correspondence address. The Office will direct all notices, official letters, and other communications relating to the application to the correspondence address. The Office will not engage in double correspondence with an applicant and a patent practitioner, or with more than one patent practitioner except as deemed necessary by the Director. If more than one correspondence address is specified in a single document, the Office will select one of the specified addresses for use as the correspondence address and, if given, will select the address associated with a Customer Number over a typed correspondence address. For the party to whom correspondence is to be addressed, a daytime telephone number should be supplied in a clearly identifiable manner and may be changed by any party who may change the correspondence address. The correspondence address may be changed as follows:

(1) Prior to filing of § 1.63 oath or declaration by any of the inventors. If a § 1.63 oath or declaration has not been filed by any of the inventors, the correspondence address may be changed by the party who filed the application. If the application was filed by a patent practitioner, any other patent practitioner named in the transmittal papers may also change the correspondence address. Thus, the inventor(s), any patent practitioner named in the transmittal papers accompanying the original application, or a party that will be the assignee who filed the application, may change the correspondence address in that application under this paragraph.

(2) Where a § 1.63 oath or declaration has been filed by any of the inventors. If a § 1.63 oath or declaration has been filed, or is filed concurrent with the filing of an application, by any of the inventors, the correspondence address may be changed by the parties set forth in paragraph (b) of this section, except for paragraph (b)(2).

(b) Amendments and other papers. Amendments and other papers, except for written assertions pursuant to § 1.27(c)(2)(ii) of this part, filed in the application must be signed by:

(1) A patent practitioner of record appointed in compliance with § 1.32(b);

(2) A patent practitioner not of record who acts in a representative capacity under the provisions of § 1.34;

(3) An assignee as provided for under § 3.71(b) of this chapter; or

(4) All of the applicants (§ 1.41(b)) for patent; unless there is an assignee of the entire interest and such assignee has taken action in the application in accordance with § 3.71 of this chapter.

(c) All notices, official letters, and other communications for the patent owner or owners in a reexamination proceeding will be directed to the attorney or agent of record (see § 1.32(b)) in the patent file at the address listed on the register of patent attorneys and agents maintained pursuant to §§ 11.5 and 11.11 of this subchapter, or, if no attorney or agent is of record, to the patent owner or owners at the address or addresses of record. Amendments and other papers filed in a reexamination proceeding on behalf of the patent owner must be signed by the patent owner, or if there is more than one owner by all the owners, or by an attorney or agent of record in the patent file, or by a registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34. Double correspondence with the patent owner or owners and the patent owner's attorney or agent, or with more than one attorney or agent, will not be undertaken. If more than one attorney or agent is of record and a correspondence address has not been specified, correspondence will be held with the last attorney or agent made of record.

(d) A "correspondence address" or change thereto may be filed with the Patent and Trademark Office during the enforceable life of the patent. The "correspondence address" will be used in any correspondence relating to maintenance fees unless a separate "fee address" has been specified. See § 1.363 for "fee address" used solely for maintenance fee purposes.

(e) A change of address filed in a patent application or patent does not change the address for a patent practitioner in the roster of patent attorneys and agents. See § 11.11 of this title.

37 C.F.R. § 1.36(a) sets forth, in toto:

A power of attorney, pursuant to § 1.32(b), may be revoked at any stage in the proceedings of a case by an applicant for patent (§ 1.41(b)) or an assignee of the entire interest of the applicant, or the owner of the entire interest of a patent. A power of attorney to the patent practitioners associated with a Customer Number will be treated as a request to revoke any powers of attorney previously given. Fewer than all of the applicants (or fewer than all of the assignees of the entire interest of the applicant or, in a reexamination proceeding, fewer than all the owners of the entire interest of a patent) may revoke the power of attorney only upon a showing of sufficient cause, and payment of the petition fee set forth in § 1.17(f). A patent practitioner will be notified of the revocation of the power of attorney. Where power of attorney is given to the patent practitioners associated with a Customer Number (§ 1.32(c)(2)), the practitioners so appointed will also be notified of the revocation of the power of attorney when the power of attorney to all of the practitioners associated with the Customer Number is revoked. The notice of revocation will be mailed to the correspondence address for the application (§ 1.33) in effect before the revocation. An assignment will not of itself operate as a revocation of a power previously given, but the assignee of the entire interest of the applicant may revoke previous powers of attorney and give another power of attorney of the assignee's own selection as provided in § 1.32(b).

Decision on Petition pursuant to 37 C.F.R. §1.181

37 C.F.R. §§ 1.321(a) and (b) set forth, in toto:

(a) A patentee owning the whole or any sectional interest in a patent may disclaim any complete claim or claims in a patent. In like manner any patentee may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted. Such disclaimer is binding upon the grantee and its successors or assigns. A notice of the disclaimer is published in the Official Gazette and attached to the printed copies of the specification. The disclaimer, to be recorded in the Patent and Trademark Office, must:

- (1) Be signed by the patentee, or an attorney or agent of record;
- (2) Identify the patent and complete claim or claims, or term being disclaimed. A disclaimer which is not a disclaimer of a complete claim or claims, or term will be refused recordation;
- (3) State the present extent of patentee's ownership interest in the patent; and
- (4) Be accompanied by the fee set forth in § 1.20(d).

(b) An applicant or assignee may disclaim or dedicate to the public the entire term, or any terminal part of the term, of a patent to be granted. Such terminal disclaimer is binding upon the grantee and its successors or assigns. The terminal disclaimer, to be recorded in the Patent and Trademark Office, must:

- (1) Be signed:
 - (i) By the applicant, or
 - (ii) If there is an assignee of record of an undivided part interest, by the applicant and such assignee, or
 - (iii) If there is an assignee of record of the entire interest, by such assignee, or
 - (iv) By an attorney or agent of record;
- (2) Specify the portion of the term of the patent being disclaimed;
- (3) State the present extent of applicant's or assignee's ownership interest in the patent to be granted; and
- (4) Be accompanied by the fee set forth in § 1.20(d).

37 C.F.R. § 3.71 sets forth, in pertinent part:

(a) Patents - conducting of prosecution. One or more assignees as defined in paragraph (b) of this section may, after becoming of record pursuant to paragraph (c) of this section, conduct prosecution of a national patent application or a reexamination proceeding to the exclusion of either the inventive entity, or the assignee(s) previously entitled to conduct prosecution.

(b) Patents - assignee(s) who can prosecute. The assignee(s) who may conduct either the prosecution of a national application for patent or a reexamination proceeding are:

(1) A single assignee. An assignee of the entire right, title and interest in the application or patent being reexamined who is of record, or

(2) Partial assignee(s) together or with inventor(s). All partial assignees, or all partial assignees and inventors who have not assigned their right, title and interest in the application or patent being reexamined, who together own the entire right, title and interest in the application or patent being reexamined. A partial assignee is any assignee of record having less than the entire right, title and interest in the application or patent being reexamined.

(c) Patents - Becoming of record. An assignee becomes of record either in a national patent application or a reexamination proceeding by filing a statement in compliance with § 3.73(b) that is signed by a party who is authorized to act on behalf of the assignee.

37 C.F.R. §1.181(f) sets forth, in toto:

The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

MPEP § 402.07 sets forth, in pertinent part::

The assignee of record of the entire interest can revoke the power of attorney of the applicant unless an "irrevocable" right to prosecute the application had been given as in some government owned applications.

...

A power of attorney by the assignee of the entire interest revokes all powers given by the applicant and prior assignees if the assignee establishes their right to take action as provided in 37 CFR 3.73(b). See MPEP § 324. Ordinarily, the applicant will still have access to the application (MPEP § 106).

Analysis

Rule §1.181(f) indicates that any petition submitted under this portion of the C.F.R. that is not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely. The present petition

was submitted over three years after the mailing of the notice of abandonment.

As such, the petition under 37 C.F.R. §1.181 is **DISMISSED** as untimely.

It is noted in passing that even if this petition were to be accepted as timely filed, it could not be granted.

Both the final Office action of April 18, 2002 and the notice of abandonment were mailed to the law firm of Oblon, Spivak, McClelland, Maier & Neustadt, P.C. (Oblon) at the address indicated above. Hence it is clear that Petitioner, Jiawei Huang of J.C. Patents, 4 Venture, Suite 250, Irvine, CA, 92618 did not receive these mailings directly from the Office.

The electronic record shows that on February 25, 2002, *prevenient* to the mailing of the final Office action discussed above, Petitioner submitted a Power of Attorney Revocation, a Power of Attorney Appointment, a Change of Address, and a terminal disclaimer.

The revocation of power of attorney and Power of Attorney was executed by Water Lur, an officer of United Microelectronics Corp., the purported assignee. However, it does not appear that an assignment has been recorded. Furthermore, the electronic file does not appear to contain a statement pursuant to Rule §3.73(b), and as such, the purported assignee has not established a right to take action. It follows that United Microelectronics Corp. is not an assignee of record, and consequently, an officer thereof lacks the authority to effectuate a power of attorney revocation or appointment.

Moreover, the Change of Correspondence Address was executed by Petitioner. Since the attempt to appoint Power of Attorney to Petitioner was ineffective, Petitioner did not have the authority to change the correspondence address, pursuant to Rule §1.33(a)(2).

Similarly, the terminal disclaimer could not be accepted, as it was signed by Petitioner. See Rules §§ 1.321(a)(1) and (b)(1).

It follows that the Revocation of Power of Attorney, the Appointment of Power of Attorney, and the Change of Address were neither entered nor made of record. Both the final Office action of April 18, 2002 and the Notice of Abandonment were properly mailed to Oblon, the address of record.

Any renewed petition under 37 C.F.R. §1.181 must be submitted within **TWO MONTHS** from the mail date of this decision.

Decision on Petition pursuant to 37 C.F.R. §1.181

Extensions of time under 37 C.F.R. §1.136(a) are permitted. The request for reconsideration should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.181," and should only address the deficiencies noted in this decision.

Alternatively, Petitioner may wish to consider filing a petition under 37 C.F.R. §§1.137(a) or (b). No assurance can be made that any remedy will be forthcoming.

Any response should indicate in a prominent manner that the attorney handling this matter is Paul Shanowski, and may be submitted by mail¹, hand-delivery², or facsimile³.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.



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1 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

2 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.

3 (571) 273-8300- please note this is a central facsimile number.